

Attorney Docket No. LEAP:123US
U.S. Patent Application No. 10/604,233
Reply to Office Action of December 10, 2004
Date: February 14, 2005

Remarks

Amendment to Drawings

The Examiner objected to the drawings as failing to comply with 37 CFR § 1.84 (p) (4). Specifically, the Examiner objected to the drawings because the reference number “42” designated both the flange of the stage well and a center plate of a microscope. Applicant thanks the Examiner for pointing out this error.

Applicant has submitted in the attached Appendix an amended drawing of Figure 2 depicting the center plate of the microscope stage. In the amended drawing, the center plate is designated by reference number “47”. Figure 2 is the only drawing figure depicting the center plate. As explained below, appropriate amendments to the specification are submitted reflecting the amendment to Figure 2. Applicant respectfully requests removal of the objection to the drawings.

Amendments to the Specification

The Examiner objected to the specification because the number “42” was used to designate both the flange of the housing of the stage well and the center plate of a microscope stage. Applicant has amended paragraphs 0026 and 0027 to designate the center plate with reference number “47”. The number “47” is not used to designate any other feature in either the text of the specification or the Figures. Applicant respectfully requests removal of this objection to the specification.

New Claims

The Examiner objected to Claims 12-15 as being dependent on a rejected base claim, but indicated that they would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. The base claim for dependent Claims 12-15 is original Claim 9.

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Amendments to the Drawings

The attached drawing sheet includes changes to Figure 2. This sheet, which includes only Figure 2, replaces the original sheet including Figure 2. In amended Figure 2, the center plate, originally referenced by reference no. 42, is now referenced by reference no. 47. Reference no. 42 now refers only to the flange of stage well 30. The amended drawing sheet is attached in the Appendix following the **Remarks** in the instant Reply.

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Applicant has added new Claims 17-20 to claim the inventions having all the limitations of original Claim 9 plus the limitations of the respective intervening claims. Applicant respectfully requests passage to allowance of new Claims 17-20.

The § 102 (b) Rejections of Claims 1-11 and 16

The Examiner rejected Claims 1-3, 8-11, and 16 under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 4,477,157 to Gaul (“Gaul” or “the ‘157 patent”). Applicant has amended independent Claims 1 and 9 and respectfully traverses the rejection of the amended claims. Applicant courteously requests reconsideration.

Applicant has amended the preamble of Claim 1 to claim a stage well for a microscope stage. In addition, Applicant has amended Claims 1 and 9 to claim a stage well in which the stage well housing extends below the microscope stage. “Below” is defined as the side of the microscope stage opposite from the microscope objectives, shown as extending from revolver 7 in Figure 1 of the ‘157 patent.

“Every element of the claimed invention must be literally present arranged as in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). (Emphasis added.) Applicant notes that housing 10 seen in the ‘157 patent is located above and supported by microscope stage 8. In contrast, the housing 30 of the instant invention is configured and claimed in both Claim 1 and Claim 9 as extending below the microscope stage. The purpose of this sub-stage extension is to provide sufficient distance between a microscope objective and large or macroscopic – sized specimens to allow microscopic examination of those specimens.

In contrast, the ‘157 patent only discloses a rotating stage supported above the nonrotating microscope stage with the microscope stage supported by the microscope stand. Therefore, it can be seen that the ‘157 patent does not disclose the stage well as arranged and claimed in amended Claims 1 and 9. For this reason, the ‘157 patent fails as a reference under § 102 (b) to anticipate amended Claims 1 and 9. Applicant respectfully requests reconsideration and passage to allowance of amended independent Claims 1 and 9.

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Claims 2, 3, and 8 depend directly or indirectly from amended Claim 1 and Claims 10-11 and 16 depend directly or indirectly from amended Claim 9 and thus incorporate all the limitations of those respective claims. Because, as discussed above, the '157 patent fails to anticipate all the elements of amended Claims 1 and 9, it also fails to anticipate Claims 2-3, 8, 10-11, and 16. Applicant respectfully requests the removal of the rejections of Claims 2, 3, 8, 10-11, and 16 and passage to allowance of those claims.

The Examiner rejected Claims 1, 4, and 6-7 under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 4,955,702 to Nakamura. Applicant has amended independent Claim 1. Applicant respectfully traverses the rejection of amended Claim 1 and requests reconsideration.

Applicant has amended independent Claim 1 to claim a stage well for a microscope stage in which the stage well housing is configured to extend below the microscope stage. The Examiner states that the preamble of original Claim 1 is not given any patentable weight as the original claim does not provide a feature or limitation for a stage well for a microscope. Applicant respectfully notes that the preamble to Claim 1 has been amended to claim a stage well specifically for a microscope stage. Further, Applicant courteously points out that Claim 1 has been further amended to claim a stage well housing that extends below the microscope stage.

Applicant respectfully submits that in light of the amendments to Claim 1 the preamble to Claim 1 should be given patentable weight. The claimed stage well is claimed as a device that extends below the microscope stage and therefore provides a feature for the microscope stage of the preamble. This fulfills the Examiner's requirement that a feature after the term "comprising" further describes or limits the microscope stage in order to give patentable weight to the preamble.

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference." *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131. (Emphasis added.) Applicant respectfully submits that the '702 patent fails to disclose each and every element of amended Claim 1 and therefore fails to anticipate that claim.

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Specifically, the '702 patent fails to disclose a housing that extends below a microscope stage. In fact, the '702 patent fails to disclose a microscope at all. Consequently, the '702 patent fails to disclose each and every element of amended Claim 1 as set forth or arranged in that claim and therefore fails as a reference under § 102 (b). Applicant respectfully requests reconsideration and passage to allowance of amended Claim 1.

Claims 4 and 6-7 depend from amended Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the '702 patent fails to anticipate all the elements of Claim 1, it also fails to anticipate Claims 4 and 6-7. Applicant respectfully requests the removal of the rejections of Claims 4 and 6-7 and passage to allowance of those claims.

The Examiner rejected Claims 1-2, 4-5 and 7 under 35 U.S.C. § 102 (b) as anticipated by the '702 patent to Nakamura. As noted above, Applicant has amended independent Claim 1 and respectfully traverses the rejection of amended Claim 1 as anticipated by the '702 patent. Applicant courteously requests reconsideration.

As stated above, Applicant respectfully submits that the '702 patent fails to disclose each element of amended Claim 1 as set forth in the claims. First, Applicant courteously points out that housing 1 in Figures 2-5 of the '702 patent does not possess a vertical groove. Applicant courteously notes that reference number 1 in the '702 patent refers to the claimed binoculars as a whole. (See '702 patent col. 2, lines 12-13.) If the Examiner is actually referring to reference number 10 as a housing, Applicant respectfully notes that the housing of amended Claim 1 is patentably distinct from housing 10 of the '702 patent. Specifically, in amended Claim 1, the stage well housing is claimed as attached to the microscope stage. This is seen in Figures 5, 7, and 8 of the instant application and described in paragraph 0027 of the specification stating, "Fasteners 45A are shown in Figure 5 removably securing stage well 30 to revolving stage 14." This is important as the attachment of the stage well by means of screws through the flange of the housing prevents the housing from rotating. In contrast, rotary barrel 10 of the '702 patent is described as "rotating freely." (See col. 2, lines 27-28 of the '702 patent.) Thus, the housing 10 disclosed in the '702 patent is not identical to the housing of the claimed stage well as set forth in

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amended Claim 1, namely because the housing of the claimed stage well cannot be rotated if it is attached to the stage.

In addition, as stated above, the '702 patent fails to disclose a housing that extends below a microscope stage, namely because the'702 patent fails to disclose a microscope stage at all. For this second reason, the '702 patent fails to disclose all the elements of amended Claim 1 as set forth in that claim. For these reasons, the '702 patent fails to anticipate all the elements of amended Claim 1 as set forth in that claim and thus fails as a reference under § 102 (b). Applicant respectfully requests reconsideration and passage to allowance of Claim 1.

Claims 2, 4, 5, and 7 depend from amended Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the '702 patent fails to anticipate all the elements of Claim 1, it also fails to anticipate Claims 2, 4, 5, and 7. Applicant respectfully requests the removal of the rejections of Claims 2, 4, 5, and 7 and passage to allowance of those claims.

In addition, Applicant specifically traverses the rejection of Claim 5 claiming a stage well depending from Claim 4 in which the groove claimed in Claim 4 is vertical. Applicant respectfully points out that the vertical groove disclosed in the '702 patent is not defined by housing 10 of the '702 patent, but rather is located in barrel 8 which is outside of barrel 10 in the '702 patent. Applicant respectfully points out that the vertical groove in Claim 5 is located on the housing 30 (analogous to housing 10 of the '702 patent). Also, Applicant courteously points out that there is no component of the claimed invention that is outside or external to the housing of the stage well. Thus it is impossible for the vertical groove of the '702 patent to anticipate the vertical groove of Claim 5 because the vertical groove of the '702 patent is a second groove, located on a separate component nonanalogous to the housing of the invention claimed in Claim 5. Thus, because the vertical groove disclosed in the'702 patent not the same vertical groove set forth in Claim 5, the '702 patent fails to anticipate Claim 5 of the instant application. Applicant respectfully requests reconsideration and passage to allowance of Claim 5.

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Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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APPENDIX